

## **REMARKS**

Claims 1, 2, 8-10 and 21-32 34-40 remain pending in the application. These claims are all rejected under 35 U.S.C. § 103 based on combinations of prior art, as follows:

A. **Claims 1 and 2** are rejected over the combination of:

- I) Sloo (U.S. Pat. No. 5,895,450);
- ii) eShare ([www.eshare.com](http://www.eshare.com), retrieved from Internet Archive Wayback Machine); and
- iii) Herz (U.S. Pat. No. 6,029,195),

B. **Claims 9 and 10** are rejected over the combination of:

- i) Sloo (U.S. Pat. No. 5,895,450); and
- ii) Siefert (U.S. Pat. No. 5,904,485),

C. **Claims 23-26, 29, 32 and 34-36** are rejected over the combination of:

- i) Sloo (U.S. Pat. No. 5,895,450);
- ii) Eisen (Are We Ready For Mediation in Cyberspace, BYU Law Review, v1998n4, pp. 1305-1358); and
- iii) Herz (U.S. Pat. No. 6,029,195),

D. **Claims 27-28** are rejected over the combination of:

- i) Sloo (U.S. Pat. No. 5,895,450);
- ii) Eisen (Are We Ready For Mediation in Cyberspace, BYU Law Review, v1998n4, pp. 1305-1358); and

iii) Herz (U.S. Pat. No. 6,029,195),

D. **Claims 8, 21-22 and 30-31** are rejected over the combination of:

- i) Sloo (U.S. Pat. No. 5,895,450);
- ii) Eisen (Are We Ready For Mediation in Cyberspace, BYU Law Review, v1998n4, pp. 1305-1358);
- iii) Herz (U.S. Pat. No. 6,029,195); and
- iv) Siefert (U.S. Pat. No. 5,904,485),

E. **Claims 37-40** are rejected over the combination of:

- i) Sloo (U.S. Pat. No. 5,895,450);
- ii) Eisen (Are We Ready For Mediation in Cyberspace, BYU Law Review, v1998n4, pp. 1305-1358); and
- iii) eShare ([www.eshare.com](http://www.eshare.com), retrieved from Internet Archive Wayback Machine).

Applicant respectfully traverses these rejections, for the reasons set forth below. Many of the rejections discussed below rely on the same cited art addressed in Applicant's Amendment filed November 19, 2004. Applicant incorporates his responses in the Amendment filed November 19, 2004 into this Amendment.

## **1. Rejection of Claims 1 and 2**

The Official Action rejected claims 1 and 2 under 35 U.S.C. § 103(a) as being obvious over Sloo in view of eShare, and further in view of Herz. This rejection is respectfully traversed. Applicant incorporates his responses to this rejection set forth in the Amendment filed November 19, 2004. Those responses are omitted for brevity.

### **A. The Official Action's Combination Of Sloo And eShare Renders Sloo Unsatisfactory For Its Intended Purpose**

The Official Action's combination of Sloo and eShare renders Sloo unsatisfactory for its intended purpose. The Official Action stated at paragraph 7:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the step of allowing interaction includes allowing a question of a party in the dispute, as disclosed by eShare, in the system disclosed by Sloo, for the advantage of providing a method of interactively settling disputes with the ability to increase the marketability of the system by incorporating public access to the dispute resolution records for entertainment and research possibilities (emphasis added).

In other words, the Official Action states that it would have been obvious to modify Sloo by incorporating public access to the dispute resolution records to allow interaction that includes allowing a question of a party in the dispute. This is contrary to the teachings of Sloo which states that one of its purposes is to maintain the privacy and anonymity of a party attempting to resolve a dispute.

Below are numerous excerpts from Sloo discussing privacy and anonymity:

**Col. 1, lines 55-62:** More particularly, the present invention provides a method and apparatus for handling complaints that allows complainants to lodge anonymous complaints against subjects, informs the subjects of the complaints, permits the subjects to respond to the complaints, encourages settlements of the complaints and holds the parties to the complaints accountable for their conduct while attempting to resolve the complaints (emphasis added).

**Col. 3, Lines 37-39:** The private communications transmitted over the communications network may be encrypted or otherwise protected using available technology (emphasis added).

**Col.5, Lines 11-19:** The program next creates a unique e-mail address in step 310 that corresponds to the data record created in step 302. The unique e-mail address is given only to the complainant and the subject so that it can be used as a private message area or as a password for entry into some type of private forum for negotiations between the complainant and the subject. This allows the complainant and subject to privately negotiate a settlement to the dispute without requiring the complainant to meet the subject face-to-face (emphasis added).

**Col. 5, Lines 38-45:** The final step in the complaint registration routine of the program occurs when the program notifies the subject that a complaint has been lodged against it as depicted in step 316. The notification, which may occur by e-mail or conventional postal service mail, preferably includes the complete detailed complaint, the complainant's suggested resolution to the complaint, the private e-mail address, and instructions on how to use the complaint handling apparatus 10 to respond to the complaint (emphasis added).

**Col. 6, Lines 7-14:** The program then prompts the subject to enter the private e-mail address or password that was created during the registration of the complaint determines whether the entered e-mail address is correct in steps 502 and 504. Since only the complainant and the subject are provided with this private e-mail address, only the subject of the complaint can enter a response to the complaint (emphasis added).

**Col. 6, Lines 43-45:** Additionally, the apparatus 10 does not disclose the actual names of the complainants to the subjects so that the complainants may remain anonymous.

**Col. 7, Lines 29-40:** If the user selected the "Settle a Dispute" option in step 212 of FIG. 2, the program moves to the steps illustrated in FIG. 7. This routine begins in step 700 which provides instructions and allows the user to proceed by selecting one of the following options: "Negotiate the Complaint" to allow the user and subject to enter into private negotiations in an attempt to resolve the complaint; "Request a Judge/Jury" to allow either the user or subject to request intervention by a third party to resolve the dispute; "Automatic Negotiator" to allow the apparatus 10 to determine a resolution to the dispute; and "Appeal a Decision" to allow either part to appeal a decision that was rendered using either of the three previous settlement options.

**Col. 7, Lines 55-63:** However, if the password or e-mail address was correctly entered, step 708 prompts the complainant or the subject to enter a private message and then stores the message in a private message area. This message area is reserved for use by the complainant and the subject and the messages entered are not posted in the public records so that the parties are encouraged to enter messages that may resolve the dispute without fear of public reaction to the messages.

As is apparent from these passages, a critical element of the system taught by Sloo is to maintain privacy and anonymity. Therefore, modifying Sloo to include public access as stated in the Official Action is not compatible with the teachings of Sloo and further destroys Sloo's intended purpose.

MPEP § 2143.01(V) states:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

The Official Action's combination states that it would have been obvious to include public access in the dispute resolution system taught by Sloo even though Sloo teachings require that "messages entered [by the parties] are not posted in the public records so that the parties are encouraged to enter messages that may resolve the dispute without fear of public reaction to the messages." Sloo Col. 7, Lines 55-63. In other words, the logic of the Office Action is to start with a primary reference and then allege that it would have been obvious to one of ordinary skill in the art to modify the primary reference in a way that is directly counter to the purpose of the primary reference. This is improper. As a result, there is no suggestion or motivation to make the proposed modification because the Official Action modifies the invention of Sloo in a manner that is unsatisfactory for Sloo's intended purpose of privacy and anonymity. Accordingly, claim 1 is can not have been obvious in view of the combination of Sloo and eShare.

**B. The Official Action's Combination Of Sloo And eShare With Herz Renders Sloo Unsatisfactory For Its Intended Purpose**

The Official Action's combination of Sloo and eShare with Herz also renders Sloo unsatisfactory for its intended purpose. This combination relies on accessing the parties' private information to generate a dispute related advertising field. In other words, when a party enters private information the system constructed in the Official Action generates information for purposes other than settling the dispute. Sloo requires that "messages entered [by the parties] are not posted in the public records so that the parties are encouraged to enter messages that may resolve the dispute without fear of public reaction to the messages." Sloo Col. 7, Lines 55-63. Therefore, the purpose of Sloo is directly

contrary to the combination set forth in the Official Action. As a result, there is no suggestion or motivation to make the proposed modification because the Official Action modifies the invention of Sloo in a manner that is unsatisfactory for Sloo's intended purpose of privacy and anonymity. Accordingly, claim 1 is not obvious in view of the combination of Sloo, eShare, and Herz.

**C. The Official Action Has Provided No Basis For Its Motivation To Combine.**

The Official Action does not cite support for its stated motivation to combine the references. MPEP § 2143.01(l) states:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art teaching, suggestion, or motivation to do so (emphasis added).

The Official Action cites Col.5, lines 9-11 of Sloo as support for its stated motivation to combine the cited art. See the Official Action paragraph 7. This portion of the Official Action does not support its stated motivation to combine the cited art. A comparison of this portion of Sloo and the motivation to combine stated in the Official Action are shown in the table below.

Sloo Col. 5, lines 9-11	Official Action's Motivation to Combine (Paragraph)
"As described in more detail below, users other than the subject and complainant can access the central computer 12 to conduct research on the business conduct of subjects."	"Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the step of allowing interaction includes allowing a question of a party in the dispute, as disclosed by eShare, in the system disclosed by Sloo, for the advantage of providing a method of interactively settling disputes with the ability <u>to increase the marketability of the system by incorporating public access to the dispute resolution records for entertainment and research possibilities</u> " (emphasis added).

As the above table demonstrates, the cited portion of Sloo does not support this extensive motivation to combine contained in the Official Action. Sloo does not discuss “the ability to increase the marketability of the system by incorporating public access to the dispute resolution records for entertainment and research possibilities.” Nor does Sloo discuss this in other portions of its specification. Therefore, Sloo does not explicitly or implicitly provide the motivation to combine. The Official Action also has not provided any basis that this knowledge was within the skill level of a person of ordinary skill in the art. According to MPEP § 2143.01(v) the Official has not provided a proper motivation to combine.

It is Applicants belief that the motivation of the Official Action comes from Applicant’s specification. The Official Action recites “entertainment” as part of its motivation. Sloo does not mention entertainment but Applicant’s specification mentions entertainment. Therefore, the evidence of record leaves only one conclusion: the motivation to combine came from Applicant’s specification. This is impermissible hindsight. For the reasons set forth above, Claim 1 is not obvious in view of the cited art.

Claim 2 depends from claim 1 and, therefore, is distinguished from the cited art for the same reasons set forth above with regard to claim 1.

Based on the foregoing, Applicant respectfully submits that claims 1 and 2 are in condition for allowance, and requests that the presently pending rejection be reconsidered and withdrawn.

## **2. Rejection of Claims 9 and 10**

The Office Action rejects claims 9-10 as obvious over the combination of Sloo and Siefert (U.S. Pat. No. 5,904,485). This rejection is traversed for the reasons set forth below.

Applicant’s invention, as recited in claim 9, includes a step that is neither

disclosed nor suggested by the cited art, namely:

...wherein the person is provided another set of questions from the larger set of questions if the person does not answer a predetermined number of the questions correctly.

The Official Action acknowledges that Sloo does not teach this step. The Official Action cites Siefert for teaching "re-assessing the knowledge level of the user." It should be noted that claim 9 recites a different step. Claim 9 recites that the person is provided another set of questions from the larger set of questions if the person does not answer a predetermined number of the questions correctly. The Official Action does not cite any art that teaches this specific step. Further, Sloo and Siefert do not disclose this step. In other words, the Official Action has not cited any art that discloses the specific step recited in claim 9. Therefore, the Official Action has failed to state a *prima facia* case of obviousness. Thus, claim 9 is distinguished from the cited art. Claim 10 depends from claim 9 and is therefore distinguished from the cited art for the same reasons set forth above with regard to claim 9.

Based on the foregoing, Applicant respectfully submits that claims 9 and 10 are in condition for allowance, and requests that the presently pending rejection be reconsidered and withdrawn.

### **3. Rejections of Claims 23-29, 32 and 34-36**

The Office Action rejects claims 23-26, 29, 32 and 34-36 as obvious over the combination of Sloo, Eisen and Herz. The Official Action also rejected claims 27 and 28 as obvious over the combination of Sloo, Eisen and Herz. These rejections are traversed for the reasons set forth below.

Sloo and Herz were discussed above with regard to claim 1. The addition of Eisen does not correct the deficiencies discussed above regarding the motivation to combine Sloo and Herz. Further, Applicant provided extensive arguments regarding Sloo, Eisen, and Herz in its Amendment filed November 10,

2004. Applicant incorporates those arguments by reference. Those arguments are omitted herein for brevity.

**A. The Official Action's Combination Of Sloo And Siefert Renders Sloo Unsatisfactory For Its Intended Purpose**

The Official Action's combination of Sloo and Siefert renders Sloo unsatisfactory for its intended purpose. The Official Action stated at paragraph 22:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the dispute resolution occurs in substantially real-time, as disclosed by Eisen in the system disclosed by the system disclosed by Sloo, for advantage of providing a method of interactively settling disputes with the ability to increase the efficiency of the system by removing time-delays between user communications (emphasis added).

In other words, the Official Action states that Sloo is modified by removing time-delays between user communications. This is contrary to the teachings of Sloo which constructs a system to maintain privacy and anonymity between the parties as discussed above with regard to claim 1. The Official Action is silent on this requirement of Sloo and how such a combination of Siefert and Sloo could exist and satisfy this requirement of Sloo. MPEP § 2143.01(V) states:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

According to MPEP § 2143.01(V) there is no suggestion or motivation to make the proposed modification because the Official Action modifies the invention of Sloo in a manner that is unsatisfactory for Sloo's intended purpose of privacy and anonymity. Accordingly, claim 23 is not obvious in view of the combination of Sloo and eShare.

Claims 24-29, 32 and 34-36 depend from claim 23 and, therefore, are distinguished from the cited art for the same reasons set forth above with regard  
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to claim 23.

## B. Claim 25

Claim 25 recites a specific step that is neither disclosed nor suggested by the cited art, namely:

...wherein the other person is a third party other than (a) one of the parties to the dispute or (b) a judge.

Claim 23 also recites:

...interaction directed towards resolving the dispute occurring in substantially real-time between at least one of the parties to the dispute and another person, wherein the substantial real-time interaction is displayed on at least a display and the display includes a dispute related advertising field including an advertisement that is selected by a computer based system.

Therefore, claim 25 requires that the “another person” interacts with one of the parties in substantially real-time. The Official Action states that Sloo discloses this step. This is not correct. Sloo expressly states that interaction between the parties is private. Specifically, Sloo states

However, if the password or e-mail address was correctly entered, step 708 prompts the complainant or the subject to enter a private message and then stores the message in a private message area. This message area is reserved for use by the complainant and the subject and the messages entered are not posted in the public records so that the parties are encouraged to enter messages that may resolve the dispute without fear of public reaction to the messages (emphasis added). Col. 7, Lines 55-63

Thus, Sloo precludes a person that is a third party other than (a) one of the parties to the dispute or (b) a judge from being involved in “substantially real-time” interactions. Thus, Sloo does not disclose this step as is asserted in the Official Action. Therefore, claim 25 is distinguished from the cited art.

**C. Claim 26**

Claim 26 recites another step that is neither disclosed nor suggested by the cited art, namely:

...enabling another third party to view the dispute without enabling the other third party to interact with the parties.

The Official Action specifically cites Sloo for disclosing this step. As is discussed above with regard to claim 25, Sloo does not permit third parties to interact or view the private negotiations between the parties. For the sake of brevity Applicant will not restate the numerous places that Sloo discloses that the interaction between the parties is private. According, claim 26 is distinguished from the cited art.

**4. Rejections of Claims 8, 21, 22, 30, and 31**

The Office Action rejects claims 8, 21, 22, 30, and 31 as obvious over the combination of Sloo, Eisen, Herz and Siefert. Each of these claims depend from claim 23 and are distinguished from Sloo, Eisen, and Herz for the reasons set forth above with regard to claim 23. Siefert was only cited for teaching the assessment of a person's knowledge. Therefore Siefert does not correct the deficiencies of the combination of Sloo, Eisen, and Herz. Claims 30 and 31 depend from claim 26 and, therefore, these claims are distinguished from the cited art for the reasons set forth above with regard to claim 26.

With regard to claims 21, 22, 30, and 31 the Official Action cited art that does not disclose the claimed features. However, the Office Action decides that in this case it doesn't matter that the cited art does not teach or suggest the limitation. Instead, the Office Action claims that the features are not functional, citing case law. The cases cited by the Office are perplexing. In *Gulack*, the claims were to an article, not a method as recited in the present application. Further, the Federal Circuit reversed the Board of Patent Appeals and Interferences, and found patentability by deciding that the printed matter on the

substrate served a functional purpose. The Federal Circuit implies that if there is printed matter on an article and the matter has nothing to do with the functioning of the article, then it would be appropriate to deny patentability of the article claim based exclusively on the printed matter. This has no relation to the presently pending method claims, where, a person's knowledge of certain types of information, facts or law, is assessed. For example, claims 21 and 22 recite assessments using different categories of information which would cause the system to operate differently to obtain those assessments.

In fact, the *Gulack* case provides excellent guidance for the Office in examining claims, such as those pending in the present case. The Court states:

Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in content of the printed matter. Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole. If the board meant to disregard that basic principle of claim interpretation, we must reverse the rejection as a matter of law.

217 U.S.P.Q. 403, 404. Applicant respectfully submits that much of the proceedings associated with this application are precisely counter to the principle set forth in this case cited by the Office. Instead of considering the claim as a whole, the Office elects to practice an improper piecemeal approach, and completely ignores parts of a claim when they are inconvenient to the Office's mission, which appears to be to continuously deny the proper issuance of a patent regardless of the facts. Applicant suggests that this application be reconsidered in light of the law clearly set forth in the case that it cited.

In *Lowry*, the Court also provided excellent guidance that is most helpful to the issuance of the presently pending claims. Here, the invention was directed to a data processing structure. Again, the Federal Circuit overruled the rejection of the Board. The Federal Circuit pointed out that

the printed matter cases have no relevance where the "invention as defined in the claims requires that the information be processed not

by the mind but by a machine, the computer."

32 U.S.P.Q.2d 1034. Clearly, the presently pending claims all include an on-line attribute and the guidance from the Court makes it clear that this rejection cannot stand.

##### 5. Rejection of Claims 37-40

Claims 37-40 stand rejected as obvious over Sloo in view of Eisen and further in view of eShare. Claims 38 and 39 depend from claim 37. This rejection relies on the improper combinations addressed above with regard to the other claims and, therefore, is improper for the reasons set forth above.

Further in its rejection of these claims, the Office Action recognizes that Sloo doesn't say anything about real time. It refers to the footnote in Eisen to conclude that this is an adequate teaching of real time, and contorts a reason to combine these disparate references, despite the fact that they won't work together and there is no suggestion to do so, by relying on the advantages taught in the present application. The Office Action then recognizes that this contorted combination fails to teach or suggest the (c) element of the claim. For this limitation, the Office Action relies on the chat function of eShare, implying that the simple existence of chat functionality which could be added to a web page (which both Sloo and Eisen are not) somehow makes obvious the entirety of element (c), and would have made such a combination obvious to one of skill in the art at the time of the invention without the benefit of hindsight from the present application. Again, the motivation for this latter combination is straight from the application, and is not present anywhere in the prior art. In reality, this combination is ludicrous, the references don't come close to teaching or suggesting the claim and the Office should follow the advice of the Federal Circuit and stop playing games.

## **B. Claims 38 and 39**

These claims depend from claim 37, and are therefore patentable for the reasons provided above. Further, claim 38 recites that steps (b) and (c) occur at substantially the same time. The Office Action states that this is “inherent to chat technology”. If such is the case, Applicant respectfully requests the Office provide a reference that is prior to the filing date of the priority document, and which teaches or suggests that real-time interaction involving a party to a dispute that is directed towards resolving the dispute inherently occurs at the same time as real time interaction between a third party (non-party, non-judge and non-juror) and a party to the dispute.

Claim 39 recites that the interaction is displayed on a display. As noted in the Office Action, it is known to display things on a display. However, as noted above, there is no teaching or suggestion in the art to display the specific interaction recited in claim 37 on a display.

## **C. Claim 40**

Claim 40, which is directed to a computer-based system, is patentable for reasons similar to claim 37. The Office Action relies on Sloo, improperly combines it with Eisen to show “real-time”, and improperly combines this combination with the chat function of eShare by relying on the advantages described in the present application. As stated earlier, this is wrong, and the Office should reconsider its position.

Based on the forgoing, the above-identified application is in condition for allowance.

Respectfully Submitted,

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Attached: Clean Copy of Claims